

PATENT

\$ 107A  
(S)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(MBHB00-716-D; RPI Ref. No. 600.016)

In re Application of:

Leonid Beigelman, et al.

Serial No.: 10/043,951

Filed: January 11, 2002

For: METHODS FOR SYNTHESIZING  
NUCLEOSIDES, NUCLEOSIDE DERIVATIVES  
AND NON-NUCLEOSIDE DERIVATIVES

Group Art Unit: 1632

Examiner: not yet known

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AUG 27 2002  
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TRANSMITTAL LETTER

Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

In regard to the above identified application,

1. We are transmitting herewith the attached:
  - (a) Notification of Loss of Entitlement to Small Entity Status (3 pgs.);
  - (b) Notification of Error in Payment of Fee(s) As a Small Entity (4 pgs.);
  - (c) Return Receipt Postcard
2. With respect to additional fees:
  - a. No additional fee is required.
  - X b. Enclosed is a check in the amount of \$828.00 for total deficiency fees owed to USPTO.
3. Please charge any deficiency in the amount due, or credit any overpayment, to Deposit Account No. 13-2490. A duplicate copy of this sheet is enclosed.
4. **CERTIFICATE OF MAILING UNDER 37 CFR § 1.10:** The undersigned hereby certifies that this Transmittal Letter and the papers, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as "Express Mail Post Office to Addressee," addressed to Commissioner for Patents, Washington, DC 20231, on August 20, 2002.

By:

*Stephen H. Docter*  
Stephen H. Docter  
Reg No. 44,659

McDONNELL BOEHNEN  
HULBERT & BERGHOFF  
300 South Wacker Drive, Suite 3200  
Chicago, Illinois 60606  
Phone: 312/913-0001  
Fax: 312/913-0002

Practitioner's Docket No. MBHB00-716-D;600.016

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

☒ In re application of: Leonid Beigelman, et al.

Application No.: 10/043,951

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Filed: January 11, 2002

Examiner: not yet known

For: Methods for Synthesizing Nucleosides, Nucleoside Derivatives and Non-Nucleoside Derivatives

☐ Patent No.:

Issued:

*\*NOTE: Insert name of inventor(s) and title also for patent where notification is with respect to maintenance fee payment, also insert application number and filing date, and add Box M. Fee to address.*

Assistant Commissioner for Patents  
Washington, D.C. 20231

**NOTIFICATION OF ERROR IN PAYMENT OF FEE(S) AS A SMALL ENTITY**  
(37 C.F.R. § 1.28(c))

*NOTE: 37 C.F.R. § 1.28(c): "(c) How errors in small entity status are excused. If status as a small entity is established in good faith, and fees as a small entity are paid in good faith, in any application or patent, and it is later discovered that such status as a small entity was established in error, or that through error the Office was not notified of a loss of entitlement to small entity status as required by § 1.27(g)(2), the error will be excused upon: compliance with the separate submission and itemization requirements of paragraphs (c)(1) and (c)(2) of this section, and the deficiency payment requirement of paragraph (c)(2) of this section."*

*NOTE: 37 C.F.R. § 1.28(c)(1): "Separate submission required for each application or patent. Any paper submitted under this paragraph must be limited to the deficiency payment (all fees paid in error), required by paragraph (c)(2) of this section, for one application or one patent. Where more than one application or patent is involved, separate submissions of deficiency payments (e.g., checks) and itemizations are required for each application or patent. See § 1.4(b)."*

**CERTIFICATION UNDER 37 C.F.R. 58 1.8(a) and 1.10\***

(When using Express Mail, the Express Mail label number is mandatory;

Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

**MAILING**

☒ deposited with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Box M. Fee, Washington, D.C. 20231

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10\*


☒ with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Addressee"

Mailing Label No. \_\_\_\_\_ (mandatory)

**TRANSMISSION**

☐ facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

  
Signature

Date: August 20, 2002

Stephen H. Docter

(type or print name of person certifying)

*\*Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.*

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00000004 10043951  
740.00 BP  
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450.00 BP  
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08/27/2002 SLURG1  
01 FC:101  
02 FC:102  
03 FC:103  
04 FC:105



### Erroneous Filing of Small Entity Statement

1. On January 11, 2002, a small entity assertion was erroneously filed in this  
☒ application  
☐ patent
2. This assertion of small entity status in this application and the payment of fee(s) as a small entity was/were made in good faith.
3. It has now been discovered that such status as a small entity was established in error.

### Itemization of the Fee(s) Erroneously Paid as Small Entity

*NOTE: 37 C.F.R. § 1.28(c)(2): "Payment of deficiency owed. The deficiency owed, resulting from the previous erroneous payment of small entity fees, must be paid.*

*(i) Calculation of the deficiency owed. The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment. The total deficiency payment owed is the sum of the individual deficiency owed amounts for each fee amount previously erroneously paid as a small entity. Where a fee paid in error as a small entity was subject to a fee decrease between the time the fee was paid in error and the time the deficiency is paid in full, the deficiency owed is equal to the amount (previously) paid in error.*

*(ii) Itemization of the deficiency payment. An itemization of the total deficiency payment is required. The itemization must include the following information:*

*(A) Each particular type of fee that was erroneously paid as a small entity, (e.g., basic statutory filing fee, two-month extension of time fee) along with the current fee amount for a non-small entity;*

*(B) The small entity fee actually paid, and when. This will permit the Office to differentiate, for example, between two one-month extension of time fees erroneously paid as a small entity but on different dates;*

*(C) The deficiency owed amount (for each fee erroneously paid); and*

*(D) The total deficiency payment owed, which is the sum or total of the individual deficiency owed amounts set forth in paragraph (c)(2)(ii)(C) of this section. "*

*NOTE: 37 C.F.R. § 1.28(c)(3): "Failure to comply with requirements. If the requirements of paragraphs (c)(1) and (c)(2) of this section are not complied with, such failure will either: be treated as an authorization for the Office to process the deficiency payment and charge the processing fee set forth in § 1.17(i), or result in a requirement for compliance within a one-month non-extendable time period under § 1.136(a) to avoid the return of the fee deficiency paper, at the option of the Office. "*

4.

(complete the following applicable item(s))

FEE(S) ERRONEOUSLY PAID AS A SMALL ENTITY	FEE ACTUALLY PAID AS A SMALL ENTITY	DEFICIENCY OWED*	CURRENT FEE
<input checked="" type="checkbox"/> Filing fee paid on <u>1/11/02</u> .	\$370.00	\$370.00	\$740.00
<input checked="" type="checkbox"/> Fee for excess claims (over 20) paid on <u>1/11/02</u> .	\$225.00	\$225.00	\$18.00
<input type="checkbox"/> Fee for multiple claims paid on _____.	\$	\$	\$
<input type="checkbox"/> Extension of time fee paid on _____.	\$	\$	\$
<input type="checkbox"/> The issue fee paid on _____.	\$	\$	\$
<input type="checkbox"/> _____ maintenance fee (First, second or third) paid on _____.	\$	\$	\$
<input checked="" type="checkbox"/> Other: a) Fee for additional independent claims (4) paid on 1/11/02	\$168.00	\$168.00	\$84.00
b) Surcharge paid on 4/03/02	\$65.00	\$65.00	\$130.00

**WARNING:** "The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment. The total deficiency payment owed is the sum of the individual deficiency owed amounts for each fee amount previously erroneously paid as a small entity. Where a fee paid in error as a small entity was subject to a fee decrease between the time the fee was paid in error and the time the deficiency is paid in full, the deficiency owed is equal to the amount (previously) paid in error. . ." 37 C.F.R. § 1.28(0)(2)(i).

**NOTE:** 37 C.F.R. § 1.28(b)(2): "The date when a deficiency payment is paid in full determines the amount of deficiency that is due pursuant to paragraph (c) of this section."

**Total deficiency owed \$ 828.00**

**NOTE:** 37 C.F.R. 1.28(d): "Payment of deficiency operates as notification of loss of status. Any deficiency payment (based on a previous erroneous payment of a small entity fee) submitted under paragraph (c) of this section will be treated under § 1.27(g)(2) as a notification of a loss of entitlement to small entity status."

**Payment of Deficiency**

5. The total deficiency owed is paid as follows:

- ☒ Attached is a ☒ check ☐ money order in the amount of \$ 828.00
- ☐ Authorization is hereby made to charge the amount of \$ \_\_\_\_\_
- ☐ to Deposit Account No. \_\_\_\_\_
- ☐ to Credit card as shown on the attached credit card information authorization form PTO-2038.

**WARNING:** Credit card information should *not* be included on this form as it may become public.

- ☒ Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

  
**SIGNATURE OF PRACTITIONER**

Reg. No.: 44,659

Stephen H. Docter  
(type or print name of practitioner)

Tel. No.: (312) 913-0001

McDonnell Boehnen Hulbert & Berghoff  
300 South Wacker Drive, Suite 3200  
Chicago, Illinois 60606

Customer No.: 20306



Practitioner's Docket No. MBHB00-716-D;600.016

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(type or print name of person certifying)

☐ Patent No.\*:

Issued:

\*NOTE: Insert name of inventors) and title also for patent. Where notification is with respect to a maintenance fee payment, also insert application number and filing date, and add Box M. Fee to address.

Assistant Commissioner for Patents  
Washington, D.C. 20231

NOTIFICATION OF LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS  
(37 C.F.R. § 1.27(g)(2))

NOTE: "Notification of loss of entitlement to small entity status is required when issue and maintenance fees are due. Notification of a loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity as defined in paragraph (a) of this section is no longer appropriate. The notification that small entity status is no longer appropriate must be signed by a party identified in § 1.33(bj). Payment of a fee in other than the small entity amount is not sufficient notification that small entity status is no longer appropriate." 37 C.F.R. § 1.27(g)(2).

NOTE: From the above portion of 37 C.F.R. § 1.27(g)(2), it is only a change in status "resulting in loss of entitlement to small entity status" that must be filed, and a change from one small entity status to another small entity status requires no notification.

CERTIFICATION UNDER 37 C.F.R. SS 1.8(a) and 1.10\*  
(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 \*

☒ with sufficient postage as first class mail.

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Mailing Label No. \_\_\_\_\_ (mandatory)

TRANSMISSION

☐ facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

Signature

Date: August 20, 2002

Stephen H. Docter  
(type or print name of person certifying)

Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term

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Applicant hereby notifies the Patent and Trademark Office that it is no longer entitled to status as a small entity, and that the assertion for small entity status, set forth

(complete a and/or b as applicable)

- a. ☒ by paying the filing fee as a small entity on January 11, 2002 (Date)
- b. ☐ by the paper filed on \_\_\_\_\_ (Date)

NOTE: "The notification that small entity status is no longer appropriate must be signed by a party identified in § 1.33(b), 37 C.F.P. § 1.27(g)(2).

35 C.F.R. § 1.33(b):

"(b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered attorney or agent of record appointed in compliance with § 1.34(b):

(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);

(3) An assignee as provided for under § 3.71 (b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

Date: August 20, 2002

Stephen H. Docter

(print or type name of person signing)

Stephen H. Docter  
Signature

P.O. Address of signatory

McDONNELL BOEHNEN  
HULBERT & BERGHOFF  
300 South Wacker Drive  
Suite 3200  
Chicago, Illinois 60606

- ☐ Inventor(s)
- ☐ Assignee(s) of complete interest
- ☐ Person authorized to sign on behalf of assignee
- ☒ Practitioner of record under § 34(b)
- ☐ Filed under § 34(a)

Registration No:

(if applicable)

Telephone No. (312) 913-0001

Reg. No. 44,659

Customer No. 20306

Ribozyme Pharmaceuticals, Inc.  
(type name of assignee)

2950 Wilderness Place  
Address of assignee

Boulder, Colorado 80301

Title of person authorized to sign on behalf of assignee

Assignment recorded in PTO 4/12/02

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